

REMARKS

Claims 1-22 and 46-83 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 3,944,342 to Martinez ("Martinez") in view of U. S. Patent No. 5,125,730 to Taylor et al. ("Taylor") and further in view of U. S. Patent No. 4,704,018 to Takhashi ("Takhashi"). Claims 84-122 and 124-150 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takhashi in view of Taylor.

To reduce issues for consideration and expedite allowance, applicants have cancelled without prejudice or disclaimer certain claims. As it is emphasized that such cancellation is without prejudice or disclaimer, applicants reserve the right to pursue claims directed to the subject matter in a related application (e.g., a continuing application).

According to the *MPEP* §2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). To prevent the use of hindsight based on the invention, an Examiner is required to show a motivation to combine the references in cases of obviousness rejections. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). The applicant's achievement may not be used to establish the obviousness of the combination. *In re Dance*, 160 F.3d 1339 (Fed. Cir. 1998). Most if not all inventions arise from a combination of old elements. *In re Werner Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). [Mere] identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.*

The Examiner will note that for purposes of expediting an allowance, claim 1 has been amended to recite an eye viewing device having a "portable" housing. Regarding claim 1, claim 1 is rejected over Martinez in view of Taylor and further in view of Takashi.

Martinez describes a table top, non-portable eye viewing device. In relevant portion, Martinez describes as follows:

A slit lamp utilizing photographic apparatus according to the present invention is illustrated in FIG. 1 and includes a head rest frame 10 mounted on a table 12 or other suitable support with a chin support 14 extending between parallel uprights of the frame 10 and vertically adjustable to permit alignment of a patient's eye level with an eye guide marker 16 on the head rest frame. A fixation light 18 is pivotally mounted on an arm 20 which extends from a rotatable support 22 carried on the top of the head rest frame such that the fixation light can be removed in an arc about the head of a patient. A carriage 24 is mounted to be movable along the table 12 relative to the head rest frame 10 by means of a spherical element, not shown, mounted in the carriage and riding on the surface of the table, the carriage 24 being slidable along a rod 26 carrying pinions 28 at its ends riding on parallel racks 30 formed in housings 32 mounted on the table. A control lever 34 extends from the carriage 24 to be moved by an operator to provide horizontal movement and fine focus of the slit lamp. *Martinez, column 3, lines 30-50.*

In view of the above passage, a table top configuration is essential to the operation of the Martinez device. The table top configuration allows a patient's head to be rested on a head rest. Further in accordance with the table top configuration, imaging elements of the Martinez device are moved horizontally relative to a patient's eye to achieve fine focus.

Applicants respectfully assert that Martinez, requiring a table top housing, teaches away from the claimed invention of claim 1, reciting a portable housing. According to *MPEP §2143.01*, a proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. Because making the device of Martinez portable will change the principle of operation of Martinez, applicants respectfully assert that the skilled artisan would not be motivated to modify Martinez in accordance with the invention of claim 1.

Regarding claim 71, which will be discussed in greater detail herein, claim 71 recites a "hand held" housing, and like claim 1, is rejected under 35 U.S.C. 103(a) with Martinez being applied as a primary reference. Applicants' respectfully assert

that since Martinez emphasizes the importance of a table top configuration, modifying Martinez in accordance with claim 71 would change the principle of operation of Martinez and further, that the skilled artisan would not be motivated to modify Martinez in accordance with claim 71.

Regarding claims reciting "portability" or "hand held" elements, the Examiner has made reference to case law, specifically, *In re Lindberg*, in which it was held that the fact that a claimed device is portable or moveable is not sufficient to patentably distinguish over an otherwise old device unless there are new or unexpected results. *194 F2d. 732, 93 USPQ 23 (CCPA 1952)*. However, according to *MPEP §2144.04*, it is not proper to rely solely on case as the rationale to support an obviousness rejection where an applicant has demonstrated criticality of a claimed limitation. With respect to applicants' portability related claims, applicants have demonstrated such criticality. For example, at paragraphs 41-42 of the specification (as published in U.S. 2002/0097379), applicants describe that portability can aid in an "eye entry" process wherein proper alignment of the device with respect to an eye is achieved:

FIGS. 1C and 1D illustrate illumination light rays exiting the device and reflecting off the eye as they are received in a viewing system of device 10 during entry of the device into an eye (during the process of moving the device into an operative position). FIG. 1C illustrates incident light rays generated by device 10 when the device is at a distance away from an operative position, while FIG. 1D illustrates received reflected light rays of a device positioned at the same distance away from an operative position as is shown in FIG. 1C. It is seen that when the device is away from an operative position, then light rays generated by the illumination system strike eye 11 in a diverged state (apex 34 of the cone of light is positioned forward of pupil 12). Thus, a relatively small percentage of incident rays enter an eye through pupil 12 and a relatively high percentage light rays are reflected from the highly reflective outer surfaces of eye structures such as iris 17 and sclera 21. Light rays reflected from outer eye structures 17 and 21 tend to be reflected at an angle with respect to imaging axis 30. The curved surface of eye 11 assures that reflected light rays are reflected at an angle with respect to axis 30. When device 10 is a substantial distance away from an operative position many light rays reflected from eye 11 during entry of the device are reflected out of the viewing system entirely as is indicated by rays 36. The majority of light rays that are received in the viewing system are blocked by aperture stop 32 as is indicated by rays 36. Only a small percentage of light rays such as rays 37 pass through aperture 33. Light rays that pass through aperture 33 consist of rays that originated as incident light rays directed substantially along axis 30 and that passed through pupil 12 to retina 19. Thus, during entry of device 10 into eye 11, it can be seen that aperture stop 32 tends to block unwanted light and to pass light corresponding to a retinal image. It will be seen that without aperture stop 32, a substantial majority of light rays transmitted to eyepiece focal plane 28 during entry would be light rays reflected from outer eye structures 17 and 21. Thus, the image received at eyepiece focal plane 28 would be heavily obscured by glare. With aperture stop 32 the substantial majority of light rays received at eyepiece focal plane correspond to retina 19. During entry into the eye, the user will see a small field image of the retina, known as the "red reflex" which helps an operator move the device into an operative position without significant glare. By maintaining the retinal image spot near the center of eyepiece focal plane 28 and moving the device

toward an eye 11, an operative position can easily be achieved. ¶ [0041-0042], U. S. Patent Publication No. 2002/0097379

Portability or "hand held" features are recited in claims 1-22, 59-66, and 71-83. Applicants traverse the citation of case law as a rationale for support of the obviousness rejections of claims 1-22, 59-66, and 71-83 on the grounds that applicants have demonstrated the criticality of the portability and hand held limitations.

Regarding claim 46, claim 46 recites among other elements "at least first and second replaceable modules, each replaceably receivable in said holder, said holder adapted to receive one of said modules at a given time, wherein said first module comprises an eyepiece lens facilitating direct view of an eye structure and said second module comprises at least an image sensor generating image signals corresponding to an eye structure." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "at least first and second replaceable modules, each replaceably receivable in said holder, said holder adapted to receive one of said modules at a given time, wherein said first module comprises an eyepiece lens facilitating direct view of an eye structure and said second module comprises at least an image sensor generating image signals corresponding to an eye structure," it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 46. The applicants note that while the Examiner alleges that Martinez has the structure of "first and second replaceable modules," Martinez does not actually have such a structure. If the Examiner wishes to maintain the rejections of claim 46 over Martinez, the Examiner is respectfully requested to demonstrate where in Martinez there is a teaching relating to "first and second replaceable modules" as recited in claim 46.

Regarding claim 71, which was referred to briefly herein, claim 71, in addition to reciting a "hand held" housing, recites among other elements "at least first and second replaceable modules, each replaceably receivable in said holder, said holder

adapted to receive one of said modules at a given time, wherein said first module comprises an eyepiece lens facilitating direct view of an eye structure and said second module comprises at least an image sensor for generating image signals corresponding to an eye structure." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "at least first and second replaceable modules, each replaceably receivable in said holder, said holder adapted to receive one of said modules at a given time, wherein said first module comprises an eyepiece lens facilitating direct view of an eye structure and said second module comprises at least an image sensor for generating image signals corresponding to an eye structure," it is believed that the Examiner has not demonstrated a case of *prima facie* obviousness as to claim 71. The applicants note that while the Examiner alleges that Martinez has the structure of "first and second replaceable modules," Martinez does not actually have such a structure. If the Examiner wishes to maintain the rejections of claim 46 over Martinez, the Examiner is respectfully requested to demonstrate where in Martinez there is a teaching relating to "first and second replaceable modules" as recited in claim 71.

Regarding claim 100, it is believed that the Examiner has rejected claim 100 under 35 U.S.C. §103(a) over Martinez in view of Takhashi. Claim 100 recites among other elements an image sensor...and "an illumination system projecting a converging cone of light converging at an apex and diverging thereafter; and a moving mirror disposed in said housing moveable between a first position at which a retinal image focal plane is defined at an active surface of said image sensor and a second position permitting visual viewing of said retina, wherein said imaging system further includes an aperture stop disposed in said housing substantially conjugate to said apex." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "an illumination system

projecting a converging cone of light converging at an apex and diverging thereafter; and a moving mirror disposed in said housing moveable between a first position at which a retinal image focal plane is defined at an active surface of said image sensor and a second position permitting visual viewing of said retina, wherein said imaging system further includes an aperture stop disposed in said housing substantially conjugate to said apex," it is believed that the Examiner has not demonstrated a case of prima facie obviousness as to claim 100.

Regarding claim 132, it is believed that the Examiner has rejected claim 132 under 35 U.S.C. §103(a) over Martinez alone. Claim 132 recites among other elements an image sensor...and "an imaging system including an imaging axis; an illumination system projecting a converging cone of light converging at an apex and diverging thereafter; wherein said imaging system further includes an aperture stop disposed in said housing substantially conjugate to said apex." The Examiner has not demonstrated and has not alleged that the prior art references have the above combination of elements. At least because the Examiner has not demonstrated, and has not even alleged that the relied upon references alone or in combination teach or suggest "an imaging system including an imaging axis; an illumination system projecting a converging cone of light converging at an apex and diverging thereafter; wherein said imaging system further includes an aperture stop disposed in said housing substantially conjugate to said apex," it is believed that the Examiner has not demonstrated a case of prima facie obviousness as to claim 132.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the office action that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his/her command. When a reference is

complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 C.F.R. 1.104(c)(2). If the Examiner will maintain the rejections of the claims including the dependent claims, the Examiner is respectfully requested to specify which claims are being rejected when references are discussed. The Examiner is further respectfully requested to specify each claim, including each dependent claim in making the rejections in accordance with the requirements of 37 C.F.R. §1.104.

While the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such limited purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

The Examiner will note that applicants have added claims 151-168. New claims 151-168 are believed to be allowable in that they recite a combination of elements not shown or suggested in the prior art of record.

No amendment herein contains new matter.


Accordingly, in view of the above amendments and remarks, applicants' believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

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Respectfully submitted,

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